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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,311	04/11/2006	Nicola Anne Burgess	13001015PCTUS	5452
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KLAUBER & JACKSON 411 HACKENSACK AVENUE HACKENSACK, NJ 07601				
EXAMINER				
HALVORSON, MARK				
ART UNIT		PAPER NUMBER		
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MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/575,311

Applicant(s)

BURGESS, NICOLA ANNE

Examiner

Mark Halvorson

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 7, 9, 28 and 29.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/MISOOK YUI/
Primary Examiner, Art Unit 1642

Continuation of 11, does NOT place the application in condition for allowance because: Claims 7, 9, 28 and 29 are rejected under 35 USC §112 for failing to comply with the enablement requirement is maintained. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention.

Factors to be considered in determining whether a disclosure meets the enablement requirement of 35 USC § 112, first paragraph, have been described by the court in *In re Wands*, 8 USPQ2d 1400 (CA FC 1988).

"Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in *Ex parte Forman*. They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims."

The claims are drawn to an *in vivo* method of treating ovarian cancer. It is noted that with respect to *in vivo* methods which rely on generally unpredictable mechanisms, "The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art." In *re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling (MPEP 2164.03)." The MPEP also states that physiological activity can be considered inherently unpredictable.

Applicants argue that the claims are enabled based on demonstrations that an antibody to CDCP1 lysed an ovarian tumor cell line in an *in vitro* ADCC assay and an antibody to CDCP1 reduced tumor reduction *in vivo* using a melanoma cell line transfected with CDCP1 that localized to the lung.

Those of skill in the art recognize that *in vitro* assays and or cell-cultured based assays are generally useful to observe basic physiological and cellular phenomenon such as screening the effects of potential drugs. However, clinical correlations are generally lacking. The greatly increased complexity of the *in vivo* environment as compared to the very narrowly defined and controlled conditions of an *in vitro* assay does not permit a single extrapolation of *in vitro* assays to human diagnostic efficacy with any reasonable degree of predictability. *In vitro* assays cannot easily assess cell-cell interactions that may be important in a particular pathological state.

Applicants argue that an antibody fragment would be expected to successfully treat ovarian cancer if a full length antibody is successful. However, there are many properties of a full length antibody, such as ADCC and CDC, that an antibody fragment would not possess. Furthermore, antibody fragment includes Fab' fragments which would not crosslink CDCP1 receptor on the surface of the cell and may not be functional. Furthermore the demonstration by Applicants that an antibody to CDCP1 lysed an ovarian tumor cell line in an *in vitro* ADCC assay would suggest that a full length antibody is required for activity *in vitro*. It is noted that the *in vitro* lysis of the ovarian cancer cell line by the antibody to CDCP1 was mediated by ADCC which does require the Fc portion of the antibody.

In response to the argument by Applicant that antibody fragments may be conjugated, the present claims do not require the antibody fragments to be conjugated to toxins.

In response to arguments that Applicant has provided *in vivo* data using a mouse model of ovarian cancer using B16 F10 cells transfected with CDCP1, it is noted that B16 F10 cells is a melanoma cell line that localizes to the lungs of mice injected with the F10 cells. There is no evidence that this animal model used by Applicant has been described elsewhere to be an animal model for ovarian cancer. Lutterbuese et al described an animal model of lung cancer using the B16 F10 cell line which is the organ that the F10 cells pointed to following administration of the cell line to mice.

Points 2 and 5 were not addressed because the evidence referred to did not appear to be submitted with Applicant's response. Evidence supporting the enablement of the claims must be submitted in the form of a publication or an affidavit under 37 CFR 1.132. MPEP2164.05. If the evidence is submitted in the form of an affidavit Applicants must provide a showing of good and sufficient reason why the evidence was not earlier presented.

In conclusion, when applicant's arguments and objective evidence are taken as a whole and weighed against the evidence supporting that undue experimentation would be required to produce the claimed invention commensurate with the scope of the claims from the written disclosure alone, the instant claims, by a preponderance of evidence, are still deemed to be not enabled..